

Serial No. 10/593,645

REMARKS

The claims are amended to recite "determining," which is supported in original claim 13 and at various places in the disclosure. There are also formal amendments.

As noted above, the Applicants provisionally elect to prosecute the species embodying Species 1, Figure 5 and claims 2, 4-7 and 15. The requirement for election is respectfully traversed as to the earlier-applied US 7,484,297 for reasons of record (which are respectfully reiterated), and also on the basis of the newly-applied US 6,389,693 to Aranda et al. The Examiner is understood to now base the election on a combination of patents which is in turn based on an assertion of obviousness in the claims, rather than on the assertion of anticipation which has now been withdrawn. The Applicants traverse on the following points:

(1) The Examiner cites MPEP §1850. This section states, "The determination [of unity of invention] is made based on the contents of the claims as interpreted in light of the description and drawings. ...[and] ... The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any)" (emphasis added). Thus, under PCT practice the drawing has only the secondary function of interpreting the claims, and is not by itself any basis for restriction. However, the Examiner appears to be following the non-PCT examination practice of basing the restriction on the drawings (page 2, lines 9-11. This basis is respectfully traversed as being contrary to the MPEP and an incorrect amalgam of two different procedures.

Serial No. 10/593,645

(2) The Applicants also note this statement: "If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention" In this application the independent claims were 1, 13, and 14 but the Examiner states (bottom of page 2) that the asserted species are defined only by the dependent claims and (page 3, line 2) that all the independent claims are generic, which implies that they therefore should not be restricted. Now, only claim 1 is independent.

(3) The Examiner requires the Applicants to "identify the claims readable on the elected species" but then states what claims are readable on the asserted species (both on page 2 of the Action). This requirement, which is taken from U.S. practice and does not belong in to the PCT-based restriction which is understood to be applied, is respectfully traversed.

(4) 37 CFR 1.475(b) is paraphrased on page 4 of the Action as stating that claims "will be considered to have unity of invention" if the claims are drawn to only one of the following ... (1) A product and a process specially adapted for the manufacturing of said product." The claims as now amended recite a product (claim 13) and a process (the other claims). As such, the election requirement appears to be contrary to 37 CFR 1.475(b).

(5) In the two paragraphs before the heading on page 3, the Examiner states that the three steps of detecting, calculating (now determining), and swaging are generic, and also states that the claims do not make any contribution over US 7,484,297

Serial No. 10/593,645

(Mayfield) in combination with US 6,389,693 (Aranda et al.). Mayfield, which was applied in the first restriction of July 7, 2010, has been withdrawn as an anticipating reference. The Examiner now applies the secondary reference, Aranda, for disclosing the step of calculating (now determining) diameter as a function of force, and cites Fig. 1 (Action at page 3, line 9).

Citation. However, there is no citation to Aranda, and Aranda does not disclose any calculation that is related to force. As to the newer step of determining, there is, likewise, no disclosure of that term being related to any force.

The Applicants have reviewed the new reference and see no disclosure of relating either calculation or determination to any force; the Examiner has supplied no citation; and there is, with respect, nothing specific to support the basis of the election requirement in the existing record.

Combination. The Examiner is, in effect, making a rejection under §103 but there is no explanation of why the two references should have been combined, nor any citation to factors (A)-(G) or MPEP § MPEP § 2141 (which states that the Examiner “must explain why the difference(s) between the prior art and the claimed invention would have been obvious ... The ‘mere existence of differences between the prior art and an invention does not establish the invention’s nonobviousness.’”).

The Applicants see that these two references teach away from one another. In the third paragraph of its Background section, Mayfield writes, “One of the difficulties ... is that ... different geometries have different fracture characteristics. Moreover, the monolith substrates have a tolerance in their diameter of +3 mm to -1 mm. Thus the

Serial No. 10/593,645

deformation alone cannot be measured.” However, this is precisely what Aranda teaches, and also claims at col. 8, line 43: “compressively closing the container ... to the predetermined container outside diameter.”

The references are seen to teach oppositely and their combination, and hence the election requirement, is therefore respectfully submitted to be lacking a firm basis.

(6) The Examiner requests a table of reference numerals and claim features with statements of support. The Applicants believe that the disclosure is written in standard English and is comprehensible. If the Examiner has any specific question, the Examiner is invited to contact Ms. Linda Jones at 202-659-2930, ext. 204, to reach the undersigned attorney.

Withdrawal of the requirement is respectfully requested.

Respectfully submitted,

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